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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,053	07/26/2001	William John Waywood	A1019/20276	7279

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Caesar, Rivise, Bernstein, Cohen & Pokotilow, Ltd.  
Seven Penn Center  
12th Floor  
1635 Market Street  
Philadelphia, PA 19103-2212

EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 02/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 1/10/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-50 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 3-6, 8-28, 30-33, 35-50 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3-6, 8-28, 30-33, and 35-50 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, applicant's amendments to the specification in the paragraph which begins on page 3, line 7 are unfortunately believed to be new matter. Although applicant has provided a Declaration which the Examiner is quite willing to believe, nevertheless it is a well known fact that a specification cannot be amended to incorporate "new matter" during prosecution or afterwards even when the material which is deleted may well be incorrect, and the material added is also correct, as applicant strongly urges here in his Declaration. Consequently, the Examiner must regretfully reject all of the claims in the application as being based upon a defective specification which contains new matter.

3. Claims 1, 3-6, 8-28, 30-33 and 35-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's newly amended admissions concerning the prior art set forth beginning at page 3, line 7 taken in view of Frognet et al., substantially for the reasons set forth in paragraph No. 5 of Paper No. 2 as

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modified herein by the following analysis. It is initially noted that the Examiner did not originally consider applicant's admission in the specification to be anticipatory in nature, as an obviousness rejection has been relied upon and a combination rejection employed. Although applicant now urges that no prior art co-extruded multilayer film has included an antistatic layer in an outer skin layer and a migratory amide in the core layer for any purpose, it must be noted that he still admits that co-extruded multilayer polyolefin films have included both the presence of an antistatic additive and a migratory amide in them. However, such structure, together with, as was previously set forth, the presence of such elements as biaxially oriented polyolefin films having printing thereon encoded with a suitable outer adhesive layer are well known. Additionally, note again the secondary reference Frognet et al., particularly at column 9 lines 8-21, particularly where it is taught that the migratory properties of both certain slip agents and certain antistatic agents will "reduce the coefficient of friction at the surface of the skin layer or layers, when sufficient aging time is provided to permit the combination to migrate to the outer surface of the film." That is, it does not appear to matter in which layer each of these additives is initially located, but only that they will migrate to the surface, i.e. the outer skin layer, if sufficient time is permitted. Finally, the teachings of the secondary

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reference which the Examiner has relied upon are again believed to provide more than ample motivation since (e.g. column 10, lines 9-12) that "the combined use of a migratory antistatic agent with a migratory slip agent results in a synergistic reduction in the coefficient of friction." Stating this another way, it does not really matter in which layer the antistatic agent in the outer skin layer and a migratory amide found initially in the intermediate or core layer are located, but only the realization that the combination of the two will eventually reduce the coefficient of friction of the film or label after being given sufficient time to migrate there.

4. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED

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STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

February 11, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zirker*